

REMARKS**Summary of the Office Action**

In the Office Action dated June 14, 2004, claims 16-19 stand withdrawn from consideration as not directed to the elected invention. Claims 1, 6, 8 and 10 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,613,486 B1 to Ohtsu et al. (hereinafter “Ohtsu”). Claim 15 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 9 are allowed. Claims 3-5, 7 and 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicants amend claims 1 and 15 to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants traverse the 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections and request reconsideration, withdrawal of all rejections and objections and the allowance of all pending claims 1-19.

The Rejections of Claims 1, 6, 8 and 10 under 35 U.S.C. §§ 102(e) and 103(a)

Claims 1, 6, 8 and 10 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over Ohtsu.

With regard to the rejection under 35 U.S.C. § 102(e), the Office Action appears to imply at page 3 that the light waveguide forming is recited only in the preamble of the claims.

Applicants respectfully submit that each of independent claims 1 and 8 recites “disposing a light waveguide forming substrate” in the body of these claims.

With regard to the rejection under 35 U.S.C. § 102(e), the Office Action asserts that the light waveguide is not recited by the Ohtsu reference. The Office Action went on to assert that the substrate of the reference would be considered capable of such utilization, in the absence of any further wave guide forming and/or product forming steps. Applicants respectfully submit that Ohtsu merely discloses a transparent substrate and that the mere transmission of light is different than being a waveguide. As such, Applicants respectfully submit that the Office Action has not provided any evidence to support the assertion at page 3 that the transparent substrate of Ohtsu “would be considered capable of such utilization, in the absence of any further wave guide forming and/or product forming steps.” Applicants respectfully request that such evidence be presented to support the assertion at page 3 that the transparent substrate of Ohtsu “would be considered capable of such utilization, in the absence of any further wave guide forming and/or product forming steps.” Absent a showing of such evidence, Applicants respectfully request that the rejections of claims 1, 6, 8 and 10 under 35 U.S.C. § 102(e) be withdrawn.

With regard to the rejection under 35 U.S.C. § 103(a), the Office Action asserts that the claims would be considered an obvious modification thereof because the substrate of the reference is capable of transmitting light. Applicants respectfully submit that Ohtsu merely discloses a transparent substrate. Applicants respectfully submit that the Office Action has not provided any evidence to support the assertion at page 3 that “the claims would be considered an

obvious modification thereover because the substrate of the reference is capable of transmitting light.” Absent a showing of such evidence, Applicants respectfully request that the alternative rejection of claims 1, 6, 8 and 10 under 35 U.S.C. § 103(a) be withdrawn.

Moreover, Applicants respectfully submit that, under the provisions of 35 U.S.C. § 103(c) as discussed in MPEP 706.02(l)(1), Ohtsu is available as a prior art under only 35 U.S.C. § 102(e) and therefore should not preclude patentability of the present invention. In this regard, Applicants respectfully submit that, at the time the invention described in the current application was made, the current application and U.S. Patent No. 6,613,486 B1 to Ohtsu et al. were commonly owned by Fuji Xerox Corporation. Accordingly, Applicants respectfully request that rejections of claims 1, 6, 8 and 10 under 35 U.S.C. § 103(a) be withdrawn.

The Rejection of Claim 15 under 35 U.S.C. § 112, Second Paragraph

Claim 15 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants amend claims 1 and 15 as provided herein to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The amendment to claims 1 and 15 is supported by the disclosure at least at page 14, lines 25-27, page 16, lines 17-26 and page 17, lines 5-14. Applicants respectfully submit that claim 15, as amended, fully complies with the requirements of 35 U.S.C. § 112, second paragraph. Applicants further submit that claim 15 should be allowed at least because of its dependence upon allowable independent claim 1 and for the additional features that it recites. Accordingly, Applicants respectfully request that the rejection of claim 15 under 35 U.S.C. § 112, second paragraph, be withdrawn.

The Objections to Claims 3-5, 7 and 11-14

Claims 3-5, 7 and 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for the indication of allowable subject matter in claims 3-5, 7 and 11-14.

Applicants respectfully submit that claims 3-5, 7 and 11-14 should be allowed at least because of their dependence upon allowable independent claim 1 and for the additional features that they recite. Accordingly, Applicants respectfully request the withdrawal of the objections to claims 3-5, 7 and 11-14.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, withdrawal of all rejections and objections, and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.


If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: September 14, 2004

By:


Baldine Brunel Paul
Registration No. 54,369

Customer No. 09629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Telephone: (202) 739-3000

Facsimile: (202) 739-3001